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IN THE

Supreme Court of the United States

OCTOBER TERM, 1953

No. 288.

JOHNSON & JOHNSON,

Petitioner,

v.

Q-TIPS, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

KENNETH PERRY,
CHESTER T. LANE,
STEWART W. RICHARDS,
Counsel for Petitioner.

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Q-TIPS, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

Petitioner, Johnson & Johnson, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit entered in the above entitled case on June 26, 1953.

Opinions Below

The opinion of the District Court (reported in part at R. P-252a, D-225a)* is reported at 108 F. Supp. 845, 860-871 (D. N. J. 1952). The opinion of the Court of Appeals has not yet been officially reported; it is printed at R. 232.

* Record page references are given as "R. ——", except that page references to Respondent's Appendix to its brief in the Court below are, for example, given as "R. P-252a" and to Petitioner's Appendix below as "R. D-225a."

Jurisdiction

The judgment of the Court of Appeals was entered on June 26, 1953 (R. 242). A petition for rehearing filed on July 24, 1953 (R. 250) was denied without opinion on July 28, 1953 (R. 261). The jurisdiction of this Court is invoked under 28 U. S. C., Section 1254(1).

Questions Presented

The court below held that petitioner's use of the term "cotton tips" in the sale of its product (consisting of packages of small wooden sticks with cotton on their tips), even though coupled with petitioner's own trade-mark "Johnson's", constituted an actionable infringement of respondent's trade-mark "Q-Tips" in the sale of a similar competing product. The face of each party's package is reproduced opposite this page from R. D-136a, 138a. The questions presented are:

1. Whether this holding was in violation of accepted principles of trade-mark law as laid down in *Warner* v. *Lilly*, 265 U. S. 526, and other decisions of this Court and of courts of appeals of circuits other than the Third Circuit; and

2. Whether this holding improperly deprived petitioner of the defense afforded by Section 33(b)(4) of the Lanham Act (Trade-Mark Act of 1946).

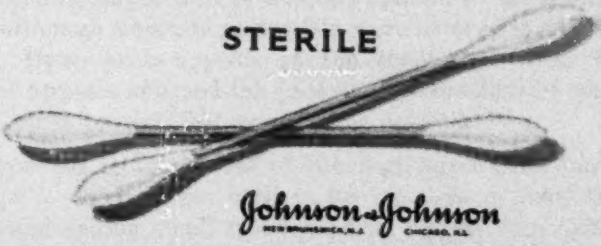
Statute Involved

The pertinent provisions of the Lanham Act (15 U. S. C., Sections 1051, *et seq.*) are set forth in the Appendix (p. 15, *infra*).

Johnson's

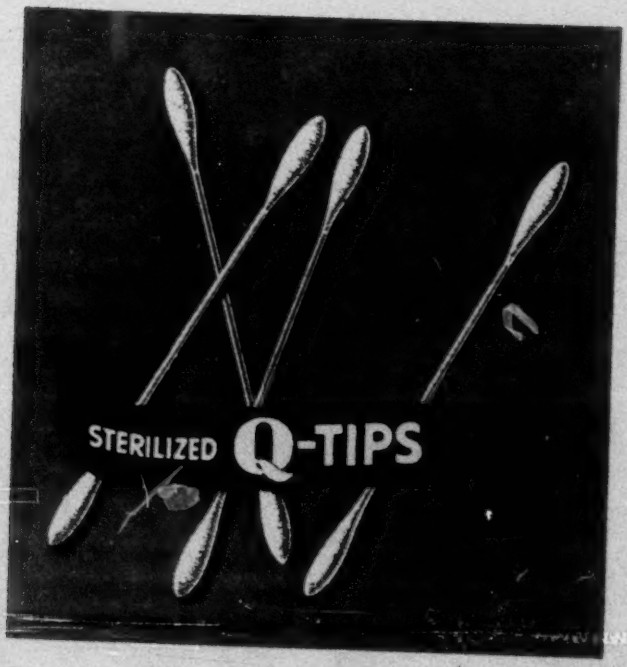
COTTON TIPS

STERILE



Johnson & Johnson

NEW BRUNSWICK, N.J. CHICAGO, ILL.



Statement

Respondent, Q-Tips, Inc., instituted two actions against petitioner, one for patent infringement and the other (the action involved on this petition) under the trade-mark laws of the United States. The actions were consolidated for trial, and disposed of in a single opinion of the district court, although separate judgments were entered in the two cases. Upon cross-appeals in the trade-mark case the court of appeals affirmed the judgment of the district court on all issues brought before it in the appeals.

Respondent is the owner of the registered trade-mark, "Q-Tips", which it has used in its business of manufacturing and selling small wooden sticks tipped with cotton at both ends—a product used primarily in the nursery for cleansing of the baby's ears and nose (R. D-225a).

Petitioner is a manufacturer of surgical dressings and related products, the most important of which is its line of "Johnson's" baby products, the first of which, Johnson's Baby Powder, has been on the market since prior to the turn of the century. The distinctive reddish orange basket weave border on plain light background has been well known as plaintiff's package dress for its baby products since long before the inception of respondent's business (R. P-273a; D-55a-56a). In October 1947 petitioner began to manufacture and market cotton-tipped sticks substantially identical with those of respondent. The product was inaugurated in packages labelled "Johnson's Cotton Tipped Applicators." Approximately a year thereafter the dress and styling of the package were changed, the distinctive package dress of its other baby products was adopted, the trade-mark "Johnson's" was continued, and the name of the product shortened to "cotton tips"* (R.

* "Johnson's" is petitioner's old established trade-mark, first used in 1887 and covered by numerous federal trade-mark registrations (Ex. D-UU; R. D-113a).

P-260a). The uniformity in format, dress and appearance of petitioner's baby products is shown by the reproduction from R. D-140a set forth in the appendix hereto.

The amended and supplemental complaint stated three causes of action: (1) that petitioner's use in commerce of the name "cotton tips" in connection with the sale of applicators for the same purposes as those of respondent, and in competition therewith, constituted an infringement upon respondent's trade-mark rights; (2) that the use of the name by petitioner and the appearance of its packages caused confusion on the part of the buying public and constituted unfair competition; and (3) that petitioner had formulated and put into operation, wilfully and maliciously, a scheme to cause the word "tips" to become accepted as a generic term for the article concerned, and thereby to dilute the value and distinctiveness of respondent's trade-mark "Q-Tips." In respect of the first two causes of action respondent sought an injunction and an accounting, with treble damages on account of the infringement, and in respect of the third it sought compensatory and punitive damages in the amount of $100,000.

In its answer petitioner denied the validity and infringement of respondent's trade-mark, and denied that it had unfairly competed with respondent, or had engaged in an attempt at dilution. Petitioner also entered a counterclaim, seeking judgment dismissing the complaint, adjudicating that the mark "Q-Tips" is invalid and cancelling respondent's registration thereof, enjoining respondent from prosecuting the companion patent suit and from engaging in restraint of trade and unfair competition with respect to petitioner, and awarding petitioner treble damages.

Following denial of a motion for summary judgment by petitioner, the case was tried before Forman, C.J., who rendered a single opinion covering both the trade-mark and the patent action.* In so far as the former is con-

* 108 F. Supp. 845. The portion of the opinion dealing with the trade-mark action appears at pp. 860-871.

cerned, the district court (1) sustained the validity of respondent's registered trade-mark, "Q-Tips"; (2) adjudicated that petitioner's use of the term "cotton tips" in connection with the sale of its swabs, under the designation "Johnson's Cotton Tips", is not the use of a term which is descriptive of petitioner's product, but is a use in the manner of and as a trade-mark, and as such infringes "Q-Tips"; (3) enjoined petitioner's use of the word "tips" in the term "cotton tips" as a trade-mark or part of a trade-mark; (4) adjudicated that petitioner's charges of violation of the anti-trust laws and other unlawful activities on respondent's part had failed both as defenses and as a counter-claim; (5) denied an accounting to respondent for profits and damages; (6) dismissed respondent's second cause of action based upon a charge of unfair competition; and (7) dismissed respondent's third cause of action based upon a charge of attempted dilution.

Petitioner appealed from those elements of the judgment numbered 1-4 above, and respondent from those numbered 5 and 7.* The court of appeals affirmed the judgment of the district court on all the issues brought before it on the appeals.

The reasoning of the court below may be summarized as follows:

1. The holding that "Q-Tips" is a valid trade-mark.

Here the issue is held to be whether "Q-Tips" has become a generic name for the goods, or is a designation descriptive of them The court concludes that "Q-Tips" falls into neither category, and is a valid trade-mark (R. 237).

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* Respondent took no appeal with respect to the dismissal of its charge of unfair competition based upon alleged confusing similarity of the dress of petitioner's package.

2. The holding that "Johnson's Cotton Tips" is confusingly similar to "Q-Tips".

The court finds that no element of confusing similarity in packaging is present, agreeing with the district court that the differences in appearance rebut any charge of "palming off". The court nevertheless finds "confusing similarity", by reference to the relevant factors as set forth in Restatement, Torts, § 729. Referring to the standard of intent, the court notes that it "can scarcely be said that 'tips' is a reasonably necessary word to describe the product to the public" (R. 238), and finds that petitioner "made its choice of 'Cotton Tips' in order to come as close as it thought legally possible to 'Q-Tips' and bask in the reflected popularity of plaintiff's [respondent's] name" (R. 238-9). Application of the other standard tests in the Restatement is said, without discussion, to support the conclusion that there is confusing similarity and thus infringement.

3. The holding that "cotton tips" is not within Section 33(b)(4) of the Lanham Act, which provides a defense to a charge of infringement even by a "confusingly similar" term if the term is used not as a trade-mark but only descriptively.

The court holds, briefly, that petitioner "endeavored to create a descriptive or generic use of the name and to carry the plaintiff's [respondent's] name along with it in such uses", but does "not think it succeeded" (R. 240).

This petition prays that a writ of certiorari issue to review so much of the judgment below as, on the basis of the foregoing holdings, affirmed the judgment of the district court adjudicating that petitioner's use of "Johnson's Cotton Tips" constituted an infringement of respondent's trade-mark "Q-Tips" and enjoining petitioner's continued use of "tips" as a trade-mark or part of a trade-mark.

Specification of Errors to be Urged

1. The court below erred in holding that petitioner's use of the term "cotton tips" in the sale of its product under the designation "Johnson's Cotton Tips" constituted an actionable infringement of respondent's trade-mark "Q-Tips".

2. The court below erred in affirming so much of the judgment of the district court as enjoined petitioner's use of the word "tips" as a trade-mark or part of a trade-mark.

Reasons for Granting the Writ

We are fully aware, not only of the "clearly erroneous" provision of F. R. C. P. 52(a), adverted to in the opinion below (R. 237), but also of the "two court" rule (*Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275), limiting the review which this Court will give to concurrent findings of fact by two courts below. Superficially, the opinion of the court of appeals would appear to bring these rules into play, so as to preclude review by this Court on certiorari. It is on its face cast as a determination of a mere factual controversy, with judgment resulting from a simple application of undisputed rules of law to the facts as found by the district court and confirmed by the court of appeals. But this is a false appearance.

The basic issue in the case, as narrowed for purposes of this petition, is whether "tips" in "Q-Tips" or "cotton tips" in "Johnson's Cotton Tips" constitutes a "designation descriptive of the goods or of their quality, ingredients, properties or functions" when applied to packages of small sticks tipped with cotton. This is the standard test, adopted by the court below from Section 715 of the Restatement of Torts, and we do not quarrel with it. It is, of course, based on the language of this Court in *Warner* v. *Lilly*, 265 U. S. 526, 528, and *Canal* v. *Clark*, 13 Wall. 311,

323. The issue here, on the undisputed facts in this record, is plainly an issue of law, not of fact.

If, as we contended below and contend here, "tips" and a fortiori "cotton tips" must as a matter of law on the undisputed facts be such a descriptive term, it must follow that the court erred in holding that petitioner's use of "tips" in "cotton tips" was an infringing use. For nothing is more clearly established in trade-mark law than that the "use of a similar name by another truthfully to describe his own product does not constitute a legal or moral wrong, *even if its effect be to cause the public to mistake the origin or ownership of the product*" [emphasis ours] (*Warner* v. *Lilly*, 265 U. S. 526, 528; see also cases there cited).*

Fundamentally, the decision below disregards these basic principles of trade-mark law, as repeatedly established by this Court and as applied with at least relative consistency by the courts of appeals for the other circuits.** More-

* The court below in its opinion broke the issue down into two questions: (1) Was there confusing similarity within the meaning of general principles of trade-mark law, and (2) if there was, was the defense under Section 33(b)(4) available? However, under the doctrine of *Warner* v. *Lilly*, even if the use of the questioned term is such as to cause confusion, there is no *actionable* "confusing similarity" if the term is truthfully used descriptively. Section 33(b)(4) of the Lanham Act merely gives statutory sanction to a trade-mark principle already developed by the courts. (Cf. *McPartland* v. *Montgomery Ward*, 164 F. 2d 603, 608, C. C. P. A., 1947, cert. denied 333 U. S. 875, dealing with the question whether Section 2(e) of the Lanham Act (15 U. S. C., Section 1052(e)) was designed to work any change in prior law as to the registrability of "descriptive" terms as trade-marks.) For this reason it is not necessary to consider in this petition whether the court below correctly found possibility of actual confusion, or whether, if its finding was incorrect, it is nevertheless an unreviewable finding of fact.

** *Thomas Kerfoot & Co., Ltd.* v. *Louis K. Liggett Co.*, 67 F. 2d 214, C. C. A. 1, 1933 (Vapex not infringed by Vapure); *L. P. Larson, Jr. Co.* v. *Wm. Wrigley, Jr. Co.*, 253 Fed. 914, C. C. A. 7, 1918, cert. denied 248 U. S. 580 (Spearmint not infringed by Peptomint); *Martin* v. *Wyeth, Inc.*, 96 F. Supp. 689, 193 F. 2d 58, C. A. 4, 1951 (Mastics not infringed by Penstix on medicated bougies); *Dixi-Cola Labs.* v. *Coca-Cola Co.*, 117 F. 2d 352, C. C. A. 4, 1941 (Coca-Cola not infringed by Dixi-Cola on soft drinks).

over, it accords an interpretation which we believe plainly erroneous to an important federal statute, the Lanham Act, which so far as we are aware has only once hitherto been before this Court for consideration (*Steele* v. *Bulova Watch Co., Inc.*, October Term 1952, No. 38, decided December 22, 1952), and then on an entirely different issue from any presented here.

As a premise, we take it to be indisputable that the term "cotton tips" *describes cotton tips,* truthfully.* And we take it to be indisputable that cotton tips are an ingredient or property of both petitioner's and respondent's product —small sticks with cotton on their tips. On what grounds, then, did the court below see fit to deny petitioner the benefit of the undisputed legal principle quoted above from *Warner* v. *Lilly*? We have searched the opinion for grounds upon which the decision can be reconciled with decisions of this Court, with decisions in other circuits, or with the Lanham Act itself. We can find none.

Possibly the court below concluded that the term "cotton tips" was not descriptive because it described only a part —not the whole—of the product. Conceding *arguendo* that the whole of the product is not described, it has never been held that to be "descriptive" in the trade-mark sense a term must describe the whole of the product. For instance, in *Warner* v. *Lilly* the product contained other substances than the chocolate and quinine upon which the allegedly infringing term was based, yet the charge of infringement was held rebutted by the defense of descriptiveness. And cf. *Rice-Stix Dry Goods Co.* v. *J. A. Scriven Co.*, 165 Fed. 639, C. C. A. 8, 1908 ("Elastic Seam" describes white cotton drawers having such a seam); *In re Packard Motor Car Company*, 46 App. D. C. 555, 1917

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* There is substantial evidence in the record that the terms "tips" and "cotton tips" have been used descriptively in the trade. See Judge Forman's opinion, R. P-264a, 267a.

("Twin-Six" describes the whole motor vehicle); *Duplex Metals Co.* v. *Standard Underground Cable Co.*, 220 Fed. 989, W. D. Pa., 1914 ("Copper Clad" describes steel wire coated with copper); *Morton Mfg. Corp.* v. *Delland Corp.*, 166 F. 2d 191, C. C. P. A., 1948 ("Stick" in "Chap Stick" held merely descriptive of shape or form of the product); *Pro-phy-lac-tic Brush Co.* v. *Hudson Products, Inc.*, 86 F. Supp. 859, D. N. J., 1949 ("Grip" held descriptive when used in "Perma-Grip" and "Poli-Grip" on denture powders). Instances could be multipled.

Or possibly the court below placed controlling weight on its own observation that: "It can scarcely be said that 'tips' is a reasonably necessary word to describe the product to the public" (R. 238). Yet it has never been held as a matter of general trade-mark law that the defense of descriptiveness in an infringement action depended on any such concept of "reasonable necessity." "To be able to find a term which is as, or even more, descriptive, does not answer the charge that the title involved is descriptive." *McGraw-Hill Pub. Co.* v. *American Aviation Associates*, 117 F. 2d 293, App. D. C., 1940; cf. *McPartland* v. *Montgomery Ward*, 164 F. 2d 603, C. C. P. A., 1947, cert. denied 333 U. S. 875. And even had there been doubt prior to the Lanham Act, that doubt would be resolved by the legislative history of Section 33(b)(4) of the Act itself. In the 1941 versions (H. R. 102 and H. R. 5461) of the bill which finally became the Lanham Act the language of the subdivision read, in part: "* * * or of a term or device which is merely descriptive of and *necessary* truthfully to describe to users the goods or services * * *" (Italics supplied). At committee hearings the American Bar Association and others proposed substituting "used in good faith" in place of "necessary truthfully", and the change was made in the Act as adopted.*

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* Hearings before a Sub-Committee of the Committee on Patents of the House of Representatives, 77th Cong., 1st Sess., on H. R. 102 and H. R. 5461, at pp. 65-67.

A third possibility in analyzing the somewhat less than clear opinion of the court below is to assume that, in dealing with the claimed defense under Section 33(b)(4) of the Lanham Act, the court was not purporting to hold "cotton tips" non-descriptive as a term, but was rather holding that the term, though descriptive, was not "used fairly and in good faith only to describe to users the goods or services * * *." Support for this interpretation of the opinion is to be found in the comments that petitioner "made its choice of 'Cotton Tips' in order to * * * bask in the reflected popularity of plaintiff's [respondent's] name" (R. 238-9), and that petitioner "endeavored to create a descriptive or generic use of the name and to carry the plaintiff's name along with it in such uses" (R. 240). In effect the holding would then be that petitioner deliberately sought to use a descriptive term in such a way as to confuse the customer as to source, and for this reason, rather than for lack of descriptiveness, must be denied the defense of Section 33(b)(4).

The difficulty with this interpretation is its inconsistency with the balance of the opinion. There could not possibly in this case be confusion as to source; every box of petitioner's cotton tips carried either petitioner's long established trade-mark "Johnson's", or the full firm name "Johnson and Johnson", no less than eleven times (R. P-251a), and the court below held specifically "that there is no such similarity in packaging that will serve as a basis for any charge of 'palming off'" (R. 233). Adding to this holding, the court below held that the doctrine of "dilution" is inapplicable to the facts (R. 234). And the court further held (R. 238-9), as had the district court (R. P-268a-269a), that petitioner intended "to come as close as it legally could" to "Q-Tips"—thus negativing any in-

ference of an intent in bad faith to cause confusion through similarity.*

We believe the opinion thus demonstrates that the court below undertook to hold specifically that petitioner's use of the term "cotton tips" is not the use of a term which is "descriptive of" petitioner's product, within the meaning of Section 33(b)(4) of the Lanham Act.** And we respectfully submit that in so holding the court was in error as a matter of law.

Significance of the Decision Below and Importance of the Question Presented

In thus discussing the opinion of the court below on an "either, or" basis, we are not to be taken as asking this Court to join us in a speculative inquiry into the precise basis of the lower court's holdings. We ask this Court, rather, to recognize that none of the possible rationalizations that can be assigned to the decision below can justify it in the light of the principles of trade-mark law which have hitherto governed decisions in comparable cases by this Court and by other circuit courts of appeals (including earlier decisions by the court of appeals for the third circuit and by lower courts in that circuit).***

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* In this connection we question seriously the propriety of the court's drawing an inference of improper intent and using such inference to support a finding of likelihood of confusion when there was no evidence in the record whatsoever of confusion, actual or probable, after more than three years of active competition, and the court itself found expressly that there was no such similarity in the packaging as could have led purchasers to mistake petitioner's product for respondent's (R. 233).

** Our conclusion is fortified by the fact that the district court did specifically so hold (R. P-270a), and that the court of appeals expressed general agreement with the district court's disposition of the issue.

*** See cases cited in our petition for rehearing in the court below, R. 251-7.

Indeed, we believe that the court below recognized the novelty of its decision when it noted, at the outset of its opinion, that the law in this situation "is in the growing stage [and] it is not to be expected that the advance in all courts will be simultaneous" (R. 235). In effect, the court below, in its aim to enforce "increasingly higher standards of fairness or commercial morality in trade" (R. 234), has, we submit, taken what it thought of as an occasion here to push the law beyond its previously accepted boundaries, in unequivocal departure from established rules of competition upon which American business has come to rely.

We denied vigorously in the court below, and would do so equally here, that petitioner ever intended to exceed any established standards of fairness or commercial morality, or ever did exceed them (R. 259). The court here has set a new standard under which the first user of any common descriptive term, as part of a fanciful combination of syllables which he chooses to use as a trade-mark for his product, may thereafter preclude the use of that term by all others in the sale of competing merchandise. Under the decision, for instance, the first user of the word "motor" in the name of his automobile could preempt the word from use by any competing car manufacturer. Or, to borrow an even more familiar analogy, one who marketed breakfast food under the name "Q-Wheat" would be entitled to an injunction against a competitor's thereafter adopting the term "Johnson's Shredded Wheat" for the same product.

To put this new standard into effect the court has had not only to disregard prevailing authority, but also to give what we see as a strained and insupportable construction to an important provision of the Lanham Act which has never heretofore been construed by this Court. The decision, if it stands unreviewed by this Court, cannot fail to cause confusion among the various circuits in a field of law which in our present era of large scale nationwide

business competition is a matter of intense and day-to-day concern to businessmen and their lawyers. Cf. *Hyde Park Clothes Inc.* v. *Hyde Park Fashions,* 204 F. 2d 223, C. A. 2, 1953. This Court's review of the decision and clarification of the principles involved would go far toward advancing the Congressional aim of providing through the Lanham Act a substantive federal system of trade-mark rights which should be uniform throughout the Union (see *S. C. Johnson & Son* v. *Johnson,* 175 F. 2d 176, 178, C. A. 2, 1949; *Dad's Root Beer Co.* v. *Doc's Beverages,* 193 F. 2d 77, 80, C. A. 2, 1951).

CONCLUSION

For the foregoing reasons this petition for a writ of certiorari should be granted.

Respectfully submitted,

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STEWART W. RICHARDS,
Counsel for Petitioner.

Appendix

Section 33 of the Lanham Act (60 Stat. 438, 15 U. S. C., Sec. 1115) provides in pertinent part as follows:

(a) Any certificate of registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of registrant's exclusive right to use the registered mark in commerce on the goods or services specified in the certificate subject to any conditions or limitations stated therein, but shall not preclude an opposing party from proving any legal or equitable defense or defect which might have been asserted if such mark had not been registered.

(b) If the right to use the registered mark has become incontestable under section 1065 of this title, the certificate shall be conclusive evidence of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate subject to any conditions or limitations stated therein except when one of the following defenses or defects is established:

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a trade or service mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe to users the goods or services of such party, or their geographic origin; * * *

Johnson's
BABY
SOAP
CASTILE
Johnson & Johnson
Johnson's
COTTON T
STERILE
Johnson & John
Johnson's
BABY
OIL
Johnson's
BABY
POWDER

TIPS
Johnson's
BABY
CREAM
2½ OZS.
Johnson & Johnson
Johnson's
BABY
LOTION
ANTISEPTIC

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Q-TIPS, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Statement

This is a suit brought by respondent for infringement of its registered trade-mark "Q-Tips" and for other unfair competition.[1] The District Court, after a lengthy trial consuming 12 court days and filling more than 1800 pages of stenographic transcript, held the trade-mark valid and infringed, but dismissed so much of respondent's complaint as was based on the allegations relating to other unfair com-

[1] Both respondent and petitioner offer the public substantially identical goods in packages of the same size and shape. The goods are generically known as swabs or cotton-tipped applicators.

petition. The Court of Appeals in a unanimous decision affirmed the District Court *in toto*. The petitioner here contends that both lower courts were in error in finding that the word "Tips" is a distinctive part of a valid trademark, "Q-Tips", and not descriptive of the product, that the respondent had made a trade-mark use of the word "Tips," and that such use constituted actual infringement. The petitioner further contends that such findings of the lower courts somehow "deprived" petitioner of the defense that petitioner was using the word "Tips" in good faith to describe its product. Petitioner has exhausted its right to appeal as a matter of right and now asks this Court to exercise its discretion and review this case on certiorari on the basis of a petition which does not set forth a single valid reason [Supreme Court Rule 38(5)] why this Court should grant certiorari. The petition merely asks this Court to retry the issues of fact which were twice decided against the petitioner below.

SUMMARY OF ARGUMENT

I

THIS COURT HAS CONSISTENTLY REFUSED TO REVIEW CONCURRENT FINDINGS OF FACT BY TWO LOWER COURTS.

II

THERE IS NO CONFLICT BETWEEN THE DECISION BELOW AND DECISIONS OF THIS COURT OR OTHER COURTS OF APPEALS.

III

RESPONDENT'S ANSWERS TO ADDITIONAL QUESTIONS PRESENTED IN THE PETITION.

ARGUMENT

I

This Court has consistently refused to review concurrent findings of fact by two lower courts.

In *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271 (1949) this Court speaking through Mr. Justice Jackson stated:

> "• • • A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error. *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275; *District of Columbia* v. *Pace*, 320 U. S. 698; *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364; *Baker* v. *Shofield*, 243 U. S. 114, 118." (p. 275)

The issues raised by the petition are purely factual in nature. Among these issues are, for example, what did the word "tips" mean in the trade when respondent adopted its mark "Q-Tips", what had it come to mean during the twenty-odd years that had elapsed before petitioner decided to re-brand its swabs with the mark "Cotton Tips" and was this re-branding likely to lead to confusion with respondent's established mark. No questions of law are raised by the petition, let alone questions of any public moment which this Court should feel called upon to review. It is not customary for this Court to review such unanimous and purely factual findings of the Courts below.

II

There is no conflict between the decision below and decisions of this Court or other Courts of Appeals.

The principle of trade-mark law that a term or terms truly descriptive of a product cannot be exclusively appro-

priated as a valid trade-mark is well established. *Warner & Co.* v. *Lilly & Co.*, 265 U. S. 526 (1924), *Canal Company* v. *Clark*, 13 Wall. 311 (U. S. 1871) and other cases cited by petitioner stand for this principle. Those decisions are not in conflict with the decision below as in those decisions the courts found *as a fact* that the words or names involved were descriptive of the product involved. In the case at bar both the courts below recognized this principle of trade-mark law, but unanimously reached the opposite factual conclusion on the voluminous record before them. The District Court held:

> "* * * In the drug trade, where cotton tipped applicators are sold, the word 'tips' without more, conveys little meaning. Until the plaintiff [respondent] popularized its product, the addition of 'Q' to 'tips' could hardly have rendered 'tips' more meaningful to the trade.* * * In the light of such an examination I am constrained to hold that the entire term 'Q-Tips' is an arbitrary symbol which has acquired the meaning of a cotton tipped applicator made by plaintiff [respondent]." (R. P263a, P264a)

The Court of Appeals held:

> "* * * 'Tips', obviously, is a regular dictionary word. It means 'the pointed or rounded end of extremity of anything.' The wood sticks, which with their cotton ends make 'Q-Tips', are rounded by the machine-applied cotton at each end. But this is a fanciful use of the term. * * *" (R. 236-7)

The only other decision regarding the trade-mark "Q-Tips" establishes unanimity of judicial thought rather than conflict. Judge Moscowitz in *Q-Tips, Inc.* v. *Glick-*

ston, 27 F. Supp. 948 (E. D. N. Y. 1939) held that "Q-Tips" was a valid trade-mark and infringed by "Twin Tips." The law applicable to the facts as found by all courts who have dealt with this trade-mark has been trenchantly expressed by this Court recently.

> "The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress. * * *" *Mishawaka Mfg. Co.* v. *Kresge Co.,* 316 U. S. 203, 205 (1942).

From the foregoing it is clear that there is no conflict between the decision below and the decisions cited by the petitioner.

III

Respondent's answers to additional questions presented in the petition.

A. The finding that petitioner's use of "Cotton Tips" is confusingly similar to "Q-Tips" is correct.

Both the courts below on the basis of the evidence before them held Johnson & Johnson's use of "Cotton Tips"

was confusingly similar to and infringed respondent's trade-mark "Q-Tips". Judge Goodrich stated for the Court of Appeals (R. 237):

> "The second question is whether the defendants have infringed the plaintiff's trade mark by their use of the term 'Johnson's Cotton Tips.' Here it is worth pointing out that 'The issue of confusing similarity is an issue of fact as to the probable or actual reactions of purchasers.'[9] This fact has been determined by the trial judge, and as a determination of a question of fact it is entitled to great respect under F. R. C. P Rule 52(a). We think the evidence is not only sufficient to support the conclusion but that it is strong enough so that it does not need the protection of the 'clearly erroneous' clause of the rule mentioned.
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>
> [Footnote by the court.]
>
> "[9] Restatement, Torts § 728, comment a. See § 729 as to the factors which are to be considered in determining confusing similarity."

It would be inappropriate here to analyze the record, but one fact of great weight which it establishes is that the respondent enjoyed the exclusive use of the expression "Tips" in a trade-mark validly identifying cotton-tipped applicators for over twenty years before the petitioner decided to adopt the brand "Cotton Tips".

B. Petitioner herein availed itself of the defense of descriptiveness as provided by the Lanham Act and consistently lost on the merits in both courts below.

Petitioner takes the position that it has been "deprived" of a defense afforded by Section 33(b)(4) of the Lanham

Act [15 U. S. C. 1115(b)(4)], to wit, that it used the trade-name "Cotton Tips" in good faith to describe its product. Petitioner was not deprived of this defense, but, on the contrary, pleaded it and introduced great quantities of evidence to substantiate it. The District Court and the Court of Appeals held that petitioner failed to prove this defense. The Court of Appeals in affirming the District Court stated:

> "Defendant makes the further point that it uses 'Cotton Tips' not as a trade mark but descriptively to tell purchasers what is in the box. Therefore, it argues, it comes within 15 U. S. C. A. § 1115(b)(4) which embodies the rule that, regardless of the validity of a plaintiff's mark and the confusing similarity to it of words used by defendant, there is no infringement if defendant uses the words not as a trade mark but only descriptively. Defendant tried its best to make it look as if it used 'Cotton Tips' descriptively. It did not claim the words as a trade mark and made no effort to register them as such. Instead it endeavored to create a descriptive or generic use of the name and to carry the plaintiff's name along with it in such uses. It changed the description of what it had formerly called 'Cotton-Tipped Applicators' in all its trade literature, price lists, and so on, to 'Cotton Tips' and embarked on a campaign to persuade its employees that the name of the product was 'Cotton Tips.' We do not think it succeeded, and neither did the district court." (R. 240)

Petitioner not only failed to prove this defense, but both courts below found petitioner guilty of attempting through its economic might to create a manufactured or synthetic descriptive meaning for the word "tips" that would make

it available for use by the petitioner. Both courts below held petitioner had failed in this energetic attempt.[2]

CONCLUSION

For the foregoing reasons the petition for writ of certiorari should be denied.

Respectfully submitted,

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Attorney for Respondent.

Dated: September 23, 1953.

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[2] The correctness of the courts' ruling is emphasized by the action of petitioner following the decision of the Court of Appeals in withdrawing from the market the offending "Cotton Tips" brand of swabs and substituting a new "Cotton Buds" brand. As shown by the attached specimen, the petitioner now employs the expression "Johnson's Cotton Buds" exactly, rhetorically and typographically, as it employed the expression "Johnson's Cotton Tips". We do not believe anyone will contend that "buds" is today a generic name for swabs.

Johnson's

COTTON BUDS

STERILE

Johnson & Johnson

NEW BRUNSWICK, N.J. CHICAGO, ILL.